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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/236,402	05/02/94	DEAN R	DITI-107

HM11/0707

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EXAMINER	
DAVENPORT, A	

ART UNIT	PAPER NUMBER
1654	29

DATE MAILED: 07/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

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August 7, 2002

Dr. Nita Minnifield
U.S. Patent and Trademark Office
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Crystal Mall 1, 7th Floor
Arlington, VA 22202-3513

RE: U.S. Patent Application No. 08/236,402
Our Ref.: 09744-006001

Dear Dr. Minnifield:

Our file does not contain an office action dated 7 July 1998 and there is nothing in any subsequent papers referring to said Office Action.

Attached is copy of an internal PTO e-mail ("Missing Parts Report") dated 21 October 1998, referencing a PTO 850 form dated 6 July 1998. Perhaps that's the missing document.

Very truly yours,

Frederick H. Rabin

FHR/bef
Attachment

30098400.doc

FR

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Cashion, Merrell

From: Cashion, Merrell
Sent: Thursday, October 22, 1998 8:19 AM
To: Kittle, John; Lee, Mary; Doll, John
Cc: McKelvey, Fred; Stoner, Bruce; Harkcom, Gary; Schafer, Richard; Lee, Jameson
Subject: Interference 104,264 (Potential): Notification of Missing Parts

Missing Parts Report

Date: October 21, 1998

To: John E. Kittle
Mary C. Lee
John J. Doll
Directors, Technology Center 1600

Via: Merrell C. Cashion, Jr.
Program and Resource Administrator

From: Fred E. McKelvey
Senior Administrative Patent Judge
Trial Section
Interference Division
Board of Patent Appeals and Interferences

Interference: 104,264

Form PTO 850 dated: July 6, 1998

Received at Board: August 10, 1998

Application: 08/236,403 ~~07/807,062~~

Patent: 5,670,133

The above-identified papers and files were forwarded to the Board of Patent Appeals and Interference for declaration of an interference (35 U.S.C. § 135(a)). The papers and files are being returned via the PTO Mail Room to the Technology Center for correction of one or more of the deficiencies noted below. Should an examiner wish to consult with an administrative patent judge and/or an interference administrator, an appointment may be made by calling 308-9797 and requesting the Trial Section.

The Form PTO 850 and the Rule 609(b) statement are deficient at least because:

1. It the count is not definite. The language "the composition" has no antecedent basis. The language "the method for radiolabeling" has ~~not~~ no antecedent basis. No steps are set out for the method for radiolabeling.

The language "the method for detecting" has not antecedent basis. No steps are set out for the method for detecting. Moreover, it is not apparent at all why the two methods are directed to the same patentable invention. Likewise not apparent is why the two methods are directed to the same patentable invention as a peptide.

2. The Form 850 does not indicate whether each claim of each application and/or patent should be designated as corresponding or as not corresponding to each count. For example, the claims of the application would appear to be 1-3, 5-8, 10-24 and 34-37. The Form 850 does not appear to mention all of these claims. The fact that claims were restricted out does not mean that the Rule 609(b) statement need not address those claims.

3. Claim 1 of the application is designated as corresponding to the count. Claim 10 of the application is designated as not corresponding to the count. Yet, in a restriction requirement (Paper 7, page 2) entered February 22, 1996, claims 1 and 10 are indicated as being to the same invention; at least there was no restriction between the invention of claim 1 and the invention of claim 10.

4. The Rule 609(b) statement does not address each claim vis-a-vis the count. The statement says that claim 34 of the application corresponds exactly to the count, but a review of claim 34 and the count will show otherwise. The mere fact that a compound of a dependent claim "is within the scope of the genus of compounds of the proposed count" does not per se mean that the compound of the dependent claim is drawn to the same patentable invention. See, e.g., In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) and Guidelines for the Examination of Claims Directed to Species of Chemical Compositions Based Upon a Single Prior Art Reference, 63 Fed. Reg 47000 (Sept. 3, 1998), reprinted in 1214 Off. Gaz. Pat. & Tm. Office 163 (Sept. 29, 1998). The language that the claim encompasses the peptide of the proposed count and the claimed reagent includes amino acids which are not encompassed by the scope of the genus of the compounds of the proposed count is simply not understood. The fact that a claim is "beyond" the scope of the proposed count does not per se mean that the claim defines an invention which is separately patentable from the count. The fact that a first compound is "analogous in structure and function" to a second compound does not per se mean the first and second compounds define the same patentable invention.

Any Rule 609(b) statement needs to address each claim individually vis-a-vis the count.

5. The last paragraph should not be included in a Rule 609(b) statement because in an interference neither party should attempt to contact the primary examiner.